

REMARKS

Claims 1 and 3 are pending in the present Application. Claim 1 has been amended, and no claims have been canceled or added, leaving Claims 1 and 3 for consideration upon entry of this amendment. A Substitute Specification in clean and marked-up versions, and a Declaration under 37 CFR § 1.132, are also included herewith.

The Specification has been amended as described above to correct the structures. No new matter has been introduced by these amendments.

Amendments to Claims

Claim 1 has been amended to replace the variable atom "C" with "E". No new matter has been introduced with these amendments.

Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, the Examiner states that the variable "C" in formula (1) is redundant as it represents a carbon, and requires amendment. Accordingly, the variable has been amended to be "E" in formula 1 and in Claim 1. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Pascal et al. (EP 1099695 A1). Applicants respectfully traverse this rejection.

Pascal et al. (EP 1099695 A1) generally disclose 5-aryl-1, 2, 4-triazole compounds and pharmaceutical compositions comprising the compounds.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally

available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

The Examiner stated that Pascal et al. teach compounds similar to the claimed 1, 2, 4-triazole derivatives, citing the entire reference and in particular p. 3, lines 42-45 of Pascal et al. The Examiner further stated that the difference between the Pascal et al. compounds and the claimed compounds is that the Pascal et al compounds are positional isomers of the claimed compounds and that the claimed compounds were *prima facie* obvious to one of ordinary skill in the art because one of ordinary skill in the art would have been motivated to prepare the compounds of the present application, which are structurally similar to the prior art compounds of Pascal et al, with the expectation that the resulting compounds would be effective, potent and selective COX-2 inhibitors.

Applicants respectfully disagree with the Examiner. Although the compound of Pascal may be a positional isomer of the claimed compound, isomers are not necessarily suggestive of each other. Isomers having the same empirical formula but different structures are not necessarily considered equivalent by chemists skilled in the art and therefore are not necessarily suggestive of each other. *Ex parte Mowry*, 91 USPQ 219 (Bd. App. 1950). It could not be said that it would be obvious to form the claimed compound by exchanging substituents of the 1st and 5th positions of 1,2,4-triazole moiety in the compound of Pascal to one having ordinary skill in the art to obtain the claimed compound.

Furthermore, a *prima facie* case of obviousness based on structural similarity is rebuttable by proof that the claimed compound possesses unexpectedly advantageous or superior properties. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Evidence that a compound is unexpectedly superior in one of a spectrum of common properties...can be enough to rebut a *prima facie* case of obviousness. *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987).

Applicants herein submit a declaration by one of the inventors, Il Hwan Cho, Ph.D., under 37 CFR § 1.132 to traverse the rejections herewith, which declaration was inadvertently omitted from the Response filed May 3, 2006 to the Office Action dated November 7, 2005. Applicants apologize for any error that may have caused the inadvertent omission of this declaration. In the declaration, Dr. Cho compares four compounds of Pascal with compounds of the present application presented in Examples 12-15 with respect to inhibition of COX-1 and COX-2. The four compounds of Pascal are positional isomers of the compounds of Examples 12-15, respectively. As shown and discussed in the declaration, each of the claimed compounds is unexpectedly superior in inhibiting COX-2 compared to the compound of Cox (See Table 1, declaration of Dr. Cho). Further Dr. Cho notes that the compounds of the present application how unexpectedly superior selectivity for inhibiting COX-2 over COX-1 in comparison with the compound of Pascal. Thus, Pascal does not render claim 1 obvious. Claim 3 depends from claim 1 and is thus also not obvious over Pascal.

Applicants therefore respectfully request reconsideration and withdrawal of the rejection of Claims 1 and 3 under §103(a) as obvious over Pascal.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,
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